

1b .

Atty. Dkt. No. 072827-0372

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

This amendment adds, changes and/or deletes a claim in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-6 are currently pending in this application. Support for claims 2-6 can be found at in the original claims and at paragraph 93 (page 42-43). Accordingly, none of the new claims introduce new matter.

The only rejections remaining in the case are a rejection for lack of enablement and a rejection for non-statutory obviousness-type double patenting. Reconsideration of the rejections is respectfully requested in view of the remarks below.

Rejection of claim 1 under 35 U.S.C. §112, First Paragraph (enablement)

Applicants respectfully traverse the rejection of claim 1 as lacking enablement. The Examiner acknowledges that the specification enables compounds of Formula VIII where Z = --CH₂CH₂-- and --OCH₂; and where R₁ and R₂ are H and Alk, but the Examiner asserts that preparation of the remaining embodiments would require undue experimentation. However, the Examiner provides no support for such an assertion.

In order to properly reject a claim for lack of enablement, the Examiner bears the burden of establishing a reasonable basis for questioning the enablement of the subject matter recited in the rejected claim. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure); see MPEP 2164.04. Specifically, "it is

Atty. Dkt. No. 072827-0372

incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." In re Marzocchi, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971) (emphasis added); see MPEP 2164.04. In this instance, Applicants respectfully emphasize that the office action does not include any explanation or objective evidence supporting the rejection for lack of enablement. Therefore, the Examiner has not met the burden required to support the rejection, and Applicants request that the rejection of claim 1 be withdrawn.

Although Applicants have no duty to rebut a rejection without reasoned support, Applicants respectfully submit that the specification of the instant application properly enables the subject matter recited in claim 1, as well as each of the new claims added through this amendment. In particular, applicants direct the Examiner to numerous compounds of formula VIII of which the structure, physical data and biological data are disclosed in the application, for example see compound 156 (structure disclosed at page 66, gas chromatography/mass spectral data disclosed at 199, biological data disclosed at page 261), compound 182 (structure disclosed at page 68, gas chromatography/mass spectral data disclosed at page 202, biological data disclosed at page 261), compound 183 (structure disclosed at page 68, gas chromatography/mass spectral data disclosed at page 202, biological data disclosed at page 261), compound 184 (structure disclosed at page 68, gas chromatography/mass spectral data disclosed at page 203, biological data disclosed at page 261), compound 187 (structure disclosed at page 68, gas chromatography/mass spectral data disclosed at page 203, biological data disclosed at page 261), compound 193 (structure disclosed at page 69, gas chromatography/mass spectral data disclosed at page 258, biological data disclosed at page 261), compound 194 (structure disclosed at page 69, gas chromatography/mass spectral data disclosed at page 258, biological data disclosed at page 261), compound 195 (structure disclosed at page 69, gas chromatography/mass spectral data disclosed at page 258, biological data disclosed at page 261), compound 196

Atty. Dkt. No. 072827-0372

(structure disclosed at page at page 69, gas chromatography/mass spectral data disclosed at page 259, biological data disclosed at page 261); compound 197 (structure disclosed at page at page 69, gas chromatography/mass spectral data disclosed at page 259, biological data disclosed at page 261). Of these formula VIII compounds, many are nearly identical to those rejected, e.g., compound 182 (where Z = O), compound 183 (where Z = S) and compound 184 (where Z = C=C). The standard for determining enablement is whether the specification as filed provides sufficient information as to permit one skilled in the art to make and use the claimed invention. *United States v. Telectronics, Inc.*, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). The test of enablement is not whether experimentation is necessary, but rather whether any experimentation that is necessary is undue. *Id.* In light of the detailed disclosure provided in the as-filed specification as well as the general knowledge of the art, Applicants submit that one skilled in the art could make and use the claimed invention without undue experimentation.

Rejection of claim 1 for non-statutory obviousness-type double patenting

Claim 1 has been rejected for non-statutory obviousness-type double patenting over claim 1 of U.S. Patent no. 6,211,645 and claim 1 of U.S. Patent no. 6,750,244. Applicants file herewith an appropriate terminal disclaimer responsive to the rejection. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees that may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to

Atty. Dkt. No. 072827-0372

Deposit Account No. 50-0872. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-0872.

Respectfully submitted,

By Barry Wilson

Barry Wilson, Reg. No. 39,431
For Richard J. Warburg, Reg. No. 32,327
Attorney for Applicant

Date July 7, 2005

FOLEY & LARDNER LLP
Customer Number: 33588
Telephone: (858) 847-6700
Facsimile: (858) 792-6773